UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/334,858	06/16/99	MANN A	PD-0294

023608
MEDTRONIC MINIMED INC.
18000 DEVONSHIRE STREET
NORTHRIDGE CA 91325-1219

QM12/0927

EXAMINER	
LAM, A	
ART UNIT	**PAPER NUMBER**
3763	10

DATE MAILED: 09/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action	Application No. 09/334,858	Applicant(s) MANN ET AL.	
	Examiner Ann Y. Lam	Art Unit 3763	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-70*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Ann Y. Lam 9/26/01

Continuation of 5. does NOT place the application in condition for allowance because: the references of record anticipate or render obvious Applicant's invention, by disclosing or teaching a device which has the structures and capabilities claimed by Applicant. Applicant argues that none of the references describes external infusion devices, but rather, are directed to implantable infusion pumps, see, for example, page 1, line 12, page6, line 26, page 18, line 16, page 19, line 4, page 20, line 17, etc.. Applicant thus argues that Applicant's invention is patentably distinguishable over the references. This argument however is not persuasive because Applicant is claiming a device, as oposed to a method of use. Thus, as long as the prior art discloses the structural limitations claimed by Applicant, and is capable of performing the functions as claimed by Applicant, then the prior art meets the limitations claimed by Applicant. Thus, the fact that Applicant claims a device that is intended to be used externally with respect to a patient does not patentably distinguish the invention over the devices in the prior art , as long as the prior art teaches the structural limitations and functional limitations as claimed by Applicant. Examiner has described in the final Office action how the prior art of record discloses or teaches the structural limitations andr the functional limitations as claimed by Applicant.

In the final Office action, Examiner cited, for example, that Matsumura, 5,050,612, discloses that a [m]icroporocessor triggers the pump to infuse insulin at a pre-programmed rate....", see column 12, lines 26-27. However, Applicant argues that the references do not disclose or teach, for example, remotely generated commands capable of programming and activating an audio bolus delivery of the liquid, (see page 8, lines 16-17), or a vibration bolus delivery (see page 8, line 25), or a temporary basal rate delivery, (see page 9, lines 8-9), or an extended bolus delivery, (see page 9, line 21), or a dual wave bolus delivery (see page 10, line 3). Examiner asserts that the references teach an infusion device with a microprocessor that is capable of performing these functions. Examiner's interpretation of these limitations as claimed is that these are programmable functions, and that the prior art references are capable of performing these functions. It may be helpful if Applicant clarifies what exactly is a vibration bolus delivery or a dual wave bolus delivery, etc., since the specification and claims do not give a clear definition of them, and also explain how the prior art devices are not capable of performing these functions.

Applicant's request for an interview is denied because Applicant's arguments are unpersuasive in light of Examiner's interpretations of the claims and prosecution is closed.

ANHTUAN T. NGUYEN
PRIMARY EXAMINER
9/26/01.